

Election

The Examiner further contends that the Applicants must elect species for the claims that are chosen to be prosecuted.

For claims to be restricted to species the different species must be mutually exclusive. M.P.E.P. § 806.04. Applicants submit that the different species outlined on pages 3 and 4 of the office action mailed February 28, 2005 are not mutually exclusive. Therefore, the restriction of all the species is improper.

With respect to process claims, the Examiner asserts with respect to the conductive layer one of the following species must be elected:

- a) the conductive layer comprises a ferromagnetic material
- b) the conductive layer comprises an element selected from the group consisting of Al, Cu, Sn or Zn.
- c) the conductive layer comprises a ferromagnetic material and nonferromagnetic material; or
- d) wherein the conductive layer is an electromagnetic shield.

For example, A and C are not mutually exclusive because if the conductive layer comprises a ferromagnetic material and nonferromagnetic material, clearly it also comprises a ferromagnetic material. Another example is that A, B, C, and D are not mutually exclusive. As discussed on page 8, lines 14-17, if "both a non-ferromagnetic material and ferromagnetic material (e.g., a layer of copper and a layer of NiFe) are used together to form the conductive layer 42, then the device portion is protected from electromagnetic fields that are both electric and magnetic with a electromagnetic or broadband shield."

With respect to the wire coupled to the leadframe, the Examiner contends one of the following species must be elected:

- a) wherein the wire is coupled to the leadframe through the semiconductor die and wire bonds; or
- b) wherein the wire is coupled to the leadframe through a pad.

A and B are not mutually exclusive. As shown in FIGs. 6 and 8 a wire can electrically couple the leadframe to the conductive layer through the semiconductor die, wire bonds, and a pad.

With respect the product claims, Applicants will only address the issues related to Group IV as Applicants have chosen not to prosecute Groups II and III due to the restriction made by the Examiner. (Applicants wish to point out that on page 3 of the office action mailed on February 28, 2005, "(B) If the *product* claims are elected..." (*emphasis added*) is in error and should be "(B) If the *process* claims are elected..." since the product claims were discussed under section (A) and the context of the rest of the sentence seems to apply to the process claims not the product claims.)

Only one of the three species listed by the Examiner applies to Group IV: a package having both ends of a wire attached to a die and a portion of the wire exposed applied is a feature of dependent claim 21 of Group IV. However, independent claim 20 and other claims of Group IV do not include this feature. (Applicants wish to point out that claim 20 of Group IV does not fit the last species listed on page 4 of the office action mailed on February 28, 2005 because claim 20 states "electrically coupling the leadframe to the conductive layer using a wire" and hence does require a wire. It is Applicants belief that the Examiner intended the third species to apply to claim 20, but it does not.)

While Applicants believe the restriction to the species is improper for all the reasons discussed above, to be fully responsive Applicants herein will elect species. For Group I with respect to the conductive layer, Applicants elect species C (ferromagnetic material and nonferromagnetic material) and with respect to the wire coupled to the leadframe, Applicants elect species A (through the die and the wire bonds).

With respect to Group IV, if the Examiner finds Applicants traversal of the restriction between Groups I and IV correct, Applicants believe that even if Group IV is included in the claims that are prosecuted no election of species of Group IV is needed because the first and third species outlined are not in the claims of Group IV and furthermore, independent claim 20 of Group 20 is not covered by any of the species listed by the Examiner. However, to be fully responsive, Applicants elect species 2 of the three species since dependent claim 21 of Group IV includes this feature.

The Examiner is reminded that the election of a species for examination purposes is not the same as a restriction. If the elected species is found patentable and the generic claim is also found patentable as limited by the species, then the additional species must be examined until all species are allowable or a species is found unpatentable. (See M.P.E.P. § 806.04 - § 806.05).

The Examiner states on page 4 of the office action mailed February 28, 2005, "Currently, no claims are generic." This is incorrect. With respect to Group I, claim 1 is clearly generic to all the species for the conductive layer and the wire coupled to the leadframe, because all of the species (for the process and product claims) are in dependent claims. Claim 1, therefore, is not limited to any of the species and thus claim 1 is generic as to Group I and the different species. With respect to Group IV, claim 20 is clearly generic like claim 1 because none of the species (for the process and product claims) are features of independent claim 20. Therefore, if the species are found patentable, the Examiner will find that the independent (which are also generic) claims of Groups I and IV are allowable with respect to the species and hence another species must be examined until all species are found patentable or a species is found unpatentable. (This is all presuming that the Examiner upholds the requirement to elect the species despite the requirement for the election being improper because the species are not mutually exclusive as required.)

If Applicant has overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 503079, Freescale Semiconductor, Inc.

Respectfully submitted,

SEND CORRESPONDENCE TO:

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